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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,018	12/05/2001	Paul L. Master	QST-016/1826P	4725

29141 7590 05/03/2004
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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,018

Applicant(s)

MASTER ET AL.

Examiner

Joy K Contee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Arguments

1. Examiner maintains rejection for claims 1-7. Kawan, 5,572,752, anticipates the Applicant's claimed "digitation file". In column 13, lines 45-58, Kawan specifically teaches that reconfiguration (i.e., reconfiguration software) of the PGA code is used to add functions (e.g., facsimile capability) which increases the utility of the electronic device (i.e., telephone-computer). Hence, Kawan inherently not only uses the reconfiguration code to define the state of the PGA but also establishes software application to provide an electronic production, such as the facsimile. Although Kawan suggests in column 11 lines 17-27 that alternative ways exist to configure a PGA chip, notwithstanding this fact, Kawan provides a teaching which requires the use of reconfiguration software as mentioned above and shown in column 10, lines 30-53 and column 13, lines 45-58.

As for the Double Patenting Rejection against claim 1. Examiner further maintains this rejection as claims 1,3,4 and 36 because the claimed adaptable hardware device which uses configurable logic is inherently the Applicant's presently claimed "electronic device".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawan et al. ("Kawan"), U.S. Patent No. 5,572,752.

Regarding claim 1, Kawan discloses a method for providing consumer products in the embedded systems market, the method comprising:

utilizing adaptive (i.e., modifiable) silicon (i.e., inherently used in electronic devices) as a hardware foundation of an electronic product (col. 10, lines 39-42); and

requiring procurement of a digitation file (i.e., means for dynamically reconfiguring) to establish a hardware designation and software application for the adaptive silicon to provide the electronic product (col. 10, lines 30-53).

Regarding claim 2, Kawan discloses the method of claim 1 further comprising utilizing the adaptive silicon as established by the digitation file to perform operations (i.e., via the reconfiguration code or software) in the electronic product (col. 10, lines 43-47).

Regarding claim 3, Kawan discloses the method of claim 1, wherein the electronic product further comprises a consumer handheld device (col. 9, lines 3-9).

Regarding claim 5, Kawan discloses the method of claim 1, further comprising downloading a new digitation file to provide an alternate hardware designation and software

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application for the adaptive silicon to provide a different electronic product (col. 12, lines 48-67 to col. 13, lines 1-7 and lines 45-50).

Regarding claim 6, Kawan discloses the method of claim 1, wherein utilizing adaptive silicon further comprises utilizing an adaptive computing engine (i.e., microcomputer) (col. 9, lines 1-2).

Regarding claim 7, Kawan discloses the method of claim 6, wherein utilizing an adaptive computing engine further comprises utilizing a controller, one or more reconfigurable matrices, a matrix interconnection network, and a memory (col. 9, lines 62-67 to col. 10, lines 1-6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan, in view of Ryan et al. ("Ryan"), U.S. Patent No. 6,311,149.

Regarding claim 4, Kawan discloses the method of claim 1. Kawan fails to explicitly disclose operating the electronic product as a cellular phone.

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However, in a similar field of endeavor Ryan teaches a reconfigurable test system which can be used for cellular phone technology (col. 1, lines 55-58 and col. 2, lines 5-13 and lines 31-40).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Kawan to include reconfigurable hardware capable of adapting to cellular phone technology for the purpose of allowing expansion to wireless devices from the standard unit as is taught in Ryan.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 36 of U.S. Patent No. 6,237,029 ('029). Although the conflicting claim is not identical, it is not patentably distinct from the others because claims 1,3,4 and 36 of '029 encompass the scope of claim 1 of the instant application.

Regarding claim 1 of the instant application, utilizing adaptive silicon as a hardware foundation of an electronic product; requiring procurement of digitation file to establish a hardware designation and software application for the adaptive silicon to provide the electronic product are claimed. In comparison, claims 1 and 36 of '029 claim, inter alia, an adaptable hardware device having an information input wherein the adaptable hardware device provides configurable logic (i.e., digitation file). Claims 1 and 36 of '029 fail to recite the inherent silicon material used in electronic devices.

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Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

Allowable Subject Matter

8. Claims 8-13 are allowed.
9. Reasons for indicating allowable subject matter: prior art fails to explicitly disclose offering the electronic product as two separate consumer items, the adaptive silicon portion and the digitations file, wherein the digitations file bears a higher percentage of a total cost of the electronic product.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing

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date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K. Contee whose telephone number is (703) 308-0149.

The Examiner can normally be reached alternating Mondays, Tuesdays and Thursdays, 5:30 a.m. to 2:00 p.m.

If attempts to reach the Examiner are unsuccessful, her supervisor, Marsha Banks-Harold can be reached on (703)305-4379.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

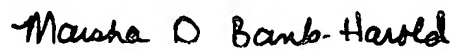
(703) 872-9306 (for formal, informal or draft communications,
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to

**Crystal Park II
Sixth Floor (Receptionist)
2121 Crystal Drive
Arlington, VA**


Joy K. Contee

April 27, 2004


MARSHA D. BANKS-HAROLD
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